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EXAMINER

POWERS, WILLIAM S

ART UNIT PAPER NUMBER

2134

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/073,261

Applicant(s)

CLARKE, JOHN RICHARD

Examiner

William S. Powers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/12/2002.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: figure 5, reference number 80.
2. The drawings are objected to because the specification identifies the Internet in figure 5 by the reference number 81, but drawings show figure 5 with reference number 81 denoting a PC.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet"

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pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The disclosure is objected to because of the following informalities:
 - a. There is no period at the end of the sentence (page 4, line 23).
 - b. The specification states "data storage media 22" (page 10, line 19), but there is no reference number 22 in figure 3 of the drawings.Appropriate correction is required.

Claim Objections

4. Claim 25 is objected to because of the following informality: The claim lacks a transitional phrase. Appropriate correction is required.

Claim Rejections - 35 USC § 112 and 35 USC § 101

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any

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person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claim 16 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not state the steps involved in protecting the control logic.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 11, the terms "significant functional capability" and "general computational activities" in claim 11 are relative terms which render the claim indefinite. Neither the term "significant functional capability" nor "general computational activities" is not defined by the claim, the specification does not

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provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

7. Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: the implementation of the protection of the control logic.

8. Claim 9 is rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device.

9. Claim 26 provides for the use of a device of claim 4 where the claim recites "[a] method of storing time-stamper data on a network" (page 8, lines 18-19 of the preliminary amendment), but, since the claim sets forth only one step involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 26 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an

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improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

10. Claims 1-6, 8-9 and 11-26 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,188,766 to Kocher.

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As to claims 1 and 13, Kocher teaches the use of a trusted clock (column 5, line 51-column 6, line 3), a time stamper (column 6, lines 4-12), a digital signature (column 6, lines 4-12), a control unit (column 5, line 51-column 6, line 3) and a memory (column 6, lines 13-25). The transitional phrase “including” is considered open-ended in this context.

As to claim 2, Kocher teaches the use of disks in the memory system (column 6, lines 13-25).

As to claims 3 and 15, Kocher teaches the use of long term memory (column 6, lines 13-25).

As to claim 4, Kocher teaches the use of a R.A.I.D. hard disk system (column 6, lines 13-25).

As to claim 5, Kocher teaches the use of a hard disk sub-system (column 6, lines 4-25).

As to claim 6, Kocher teaches the use of a time stamper with a trusted clock that can be a smart-card (column 7, lines 59-64).

As to claims 8 and 16, Kocher teaches the use of a tamper resistant housing as a security precaution for the apparatus (column 13, lines 40-45).

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As to claims 9, 17, 18 and 19, Kocher teaches the use of a sender identification sub-system to determine the type of transaction desired (column 5, lines 39-50).

As to claim 11, Kocher does not teach any significant functional capability beyond that which is claimed in claim 1.

As to claim 12, Kocher teaches the use of a trusted clock (column 5, line 51-column 6, line 3), a time stamper (column 6, lines 4-12), a digital signature (column 6, lines 4-12), a memory (column 6, lines 13-25) and a tamper resistant housing as a security precaution for the apparatus (column 13, lines 40-45). The transitional phrase "including" is considered open-ended in this context.

As to claims 14, 22, 24 and 25, Kocher teaches the use of a trusted clock (column 5, line 51-column 6, line 3), a time stamper (column 6, lines 4-12), a digital signature (column 6, lines 4-12), a control unit (column 5, line 51-column 6, line 3) and a memory (column 6, lines 13-25).

As to claims 20, 23 and 26, Kocher teaches receiving transmitted data over a public network (column 5, lines 1-5) and saving time-stamped data in a secure storage sub system (column 6, lines 4-25).

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As to claim 21, Kocher teaches the use of hashing the original data before applying the time-stamp (column 7, line 47-column 8, line 10).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,188,766 to Kocher in view of U.S. Patent No. 5,001,752 to Fisher.

As to claims 7 and 10, Kocher teaches the use of a trusted clock connected to the time stamping/archiving apparatus (column 5, lines 51-63), but does not expressly mention the connection being hard wired or the method of ensuring that the trusted time is accurate.

Fisher teaches the use of a plurality trusted clocks that are embedded in a date/time notary device (column 3, line 47-column 4, line 27) in order to check the accuracy of the clocks by averaging the time among the plurality of said trusted clocks and generate an error if any of the clocks fail or the average

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difference between the times is above a threshold amount (column 3, line 47-column 4, line 27).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to combine the time stamping of electronic documents with a trusted clock of Kocher with the embedded plurality of trusted clocks of Fisher in order to check the accuracy of the clocks by averaging the time among the plurality of said trusted clocks and generate an error if any of the clocks fail or the average difference between the times is above a threshold amount (column 3, line 47-column 4, line 27).

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent Application No. 2002/0104004 to Couillard teaches a trusted clock, time stamping and tamper resistance.

U.S. Patent No. 5,189,700 to Blandford teaches a smart card, removable storage media, trusted clock and tamper evident protection.

U.S. Patent No. 6,792,536 to Teppler teaches a smart card, removable storage media, controller and digital signatures.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to William S. Powers, whose telephone number is (571) 272-8573. The examiner can normally be reached Monday-Thursday from 8 AM – 4:30 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse, can be reached at (571) 272-3838.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
PO Box 1450
Alexandria, VA 22313-1450

Or faxed to:

(571) 273-8300

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR

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system, contact the Electronic Business Center (EBC) at (886) 217-9197 (toll-free).


WSP

October 18, 2005


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